

Appl. No. : **09/785,044**
Filed : **February 14, 2001**

REMARKS

Claims 1, 5, 6, 9, 10, 11, 12, 13 and 17 are amended and Claims 18-47 are added by this paper. Claims 2-4, 7-8 and 14-16 are unchanged. Claims 1-47 are pending in the application. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested. The amendment of "patient health item" to "patient health condition" in Claim 11 and the amendments to correct the antecedent basis in Claims 6, 11 and 17 are for clarification purposes only as requested by the Examiner and are not intended to avoid prior art or to be narrowing.

Discussion of Claim Objections

The Office Action stated that Claims 6, 10, 12-13 and 17 are objected to because of informalities. Applicant believes that the Examiner objected to Claim 11 rather than Claim 10. In response, Applicant has amended Claims 6, 11-13 and 17 to correct the informalities.

Discussion of the Rejections Under 35 U.S.C. § 101

Claims 6-8 and 11-17 were rejected under 35 U.S.C. § 101 as being directed to non-statutory matter. Applicant has amended Claims 6 and 11 to overcome the rejection as discussed at the personal interview.

Discussion of the Rejections Under 35 U.S.C. § 103(a)

Claims 1-5 and 9-10 were rejected under 35 U.S.C. § 103(a) as being obvious over Branson et al. (U.S. Patent No. 6,598,035) in view of Gray (U.S. Patent No. 6,149,585). Claims 11-13 and 15-17 were rejected under 35 U.S.C. § 103(a) as being obvious over Iliff (U.S. Patent No. 5,868,669) in view of Gray. Claim 14 was rejected under 35 U.S.C. § 103(a) as being obvious over Iliff in view of Gray and further in view of Branson et al.

Prima Facie Obviousness Requires a Teaching or Suggestion of All Claim Limitations

M.P.E.P. § 2143.03 recites that all claim limitations must be taught or suggested. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in

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a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Analysis

Claims 1 and 11

Regarding Claim 1, the Office Action states that the Gray patent discloses diseases, but Applicant respectfully submits that Gray does not describe disease objects. The Office Action also states that "Branson does not explicitly disclose a disease object". Furthermore, the combination of Branson and Gray do not disclose the feature of preferred symptoms, alternative symptoms and their corresponding weights as discussed at the personal interview. Moreover, the combination of Branson and Gray do not disclose that "the alternative symptoms for a particular preferred symptom are selected from a set of archived symptom objects that are available for reuse" as recited in part in Claim 1. In the description of the alternative symptom feature, the specification at page 31, lines 17-18 recites: "Many of these symptoms may be the same, or acceptably similar variations of each other". This is in direct contrast to the symptoms described at lines 25-48 in column 6 of Gray where there is no discussion of the alternative symptoms for a particular preferred symptom.

Regarding Claim 11, the Office Action states that "Iliff teaches a particular preferred symptom has one or more related alternative symptoms that represent different approaches for eliciting further diagnostic information related to the same patient health item". Applicant respectfully submits that the patient health item (now amended to be "patient health condition") is not the same as "diagnostic screen questions, migraine screening questions, and migraine confirmation questions, line 24 in col. 35 thru line 49 in col. 42)". The diagnostic screen questions, migraine screening questions, and migraine confirmation questions are broad categories of questions, and are not patient health items or patient health conditions. Applicant has amended "patient health item" to be "patient health condition" pursuant to the personal interview so as to clarify the claim. However, Applicant respectfully submits that "condition" is the same as "item" in view of the description of "patient health item" in the specification at page 15, lines 13-16.

The Office Action states that the Gray patent discloses a plurality of diseases, but Applicant respectfully submits that Gray does not describe disease objects. Furthermore, the combination of

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Iliff and Gray do not disclose the feature of preferred symptoms, alternative symptoms and their corresponding weights as discussed at the personal interview. Moreover, the combination of Iliff and Gray do not disclose that "the alternative symptoms are selected from a set of archived symptom objects that are available for reuse" as recited in part in Claim 11.

Claim 9

Regarding Claim 9, the Office Action states that "the limitations of claim 9 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis". The discussion for Claim 1 regarding diseases and disease objects applies here as well. Namely, the Office Action states that the Gray patent discloses diseases, but Applicant respectfully submits that Gray does not describe disease objects. The Office Action also states that "Branson does not explicitly disclose a disease object". Moreover, Applicant recites "wherein the objects include at least a plurality of disease objects, a plurality of symptom objects and a plurality of valuator objects" in part in Claim 9. Applicant respectfully submits that the combination of Branson and Gray furthermore do not disclose the valuator objects.

Prima facie Obviousness Requires a Suggestion or Motivation and an Expectation of Success

As stated in the Manual of Patent Examining Procedure 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the

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claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

When an obviousness rejection is based on multiple prior art references, there must be a showing of a teaching, suggestion, or motivation to combine the references. Although the references need not expressly teach that their disclosures should be combined, the showing of combinability must be "clear and particular". *Winner Int'l Royalty Corp. v. Wang*, 2002 F.3d 1340, 1348-1349 (Fed Cir. 2000) (citing *In re Dembicza*k, 175 F.3d 994,999 (Fed. Cir. 1999)). Motivation to combine requires desirability. *Id.*

As stated in the Manual of Patent Examining Procedure 2143.01, the fact that references can be combined or modified is not sufficient to establish prima facie obviousness. The fact that that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish prima facie obviousness.

Analysis

The Office Action does not provide the required suggestion or motivation to combine the references for the independent claims. The Office Action needs to provide an objective reason to combine the teachings of the references and to provide the source of the suggestion that one would combine an object-oriented expert system framework mechanism with a system that suggests a next diagnostic task and does not use objects. The fact that references can be combined or modified, or the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish prima facie obviousness.

Thus, Applicant respectfully submits that the Examiner has not met his prima facie burden to provide an objective reason to combine the teachings of the references and to provide the source of the suggestion, and has not presented a convincing line of reasoning, where the showing of combinability must be "clear and particular".

Discussion of the Rejections Under 35 U.S.C. § 102(b)

Claims 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Iliff (U.S. Patent No. 5,868,669).

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The Iliff reference is directed to medical complaint algorithms. Each algorithm is specific to a particular medical condition. The medical complaint algorithm is executed in the computer and diagnoses a medical condition. Although the medical complaint algorithms are associated with diseases and symptoms, and may be programmed in the programming language C++, the Iliff reference does not describe "a plurality of objects which interact to determine a diagnosis of a patient, ... wherein the objects are arranged in a hierarchical relationship such that the result of one of the objects is input to another of the objects", as recited in part in Claim 6. There is no description whatsoever in Iliff of the recited objects being arranged in a hierarchical relationship and that the result of one of the objects is input to another of the objects. See Applicant's Figure 29b as reproduced below as an embodiment of "the objects are arranged in a hierarchical relationship such that the result of one of the objects is input to another of the objects".

USING OBJECTS FOR DIAGNOSIS

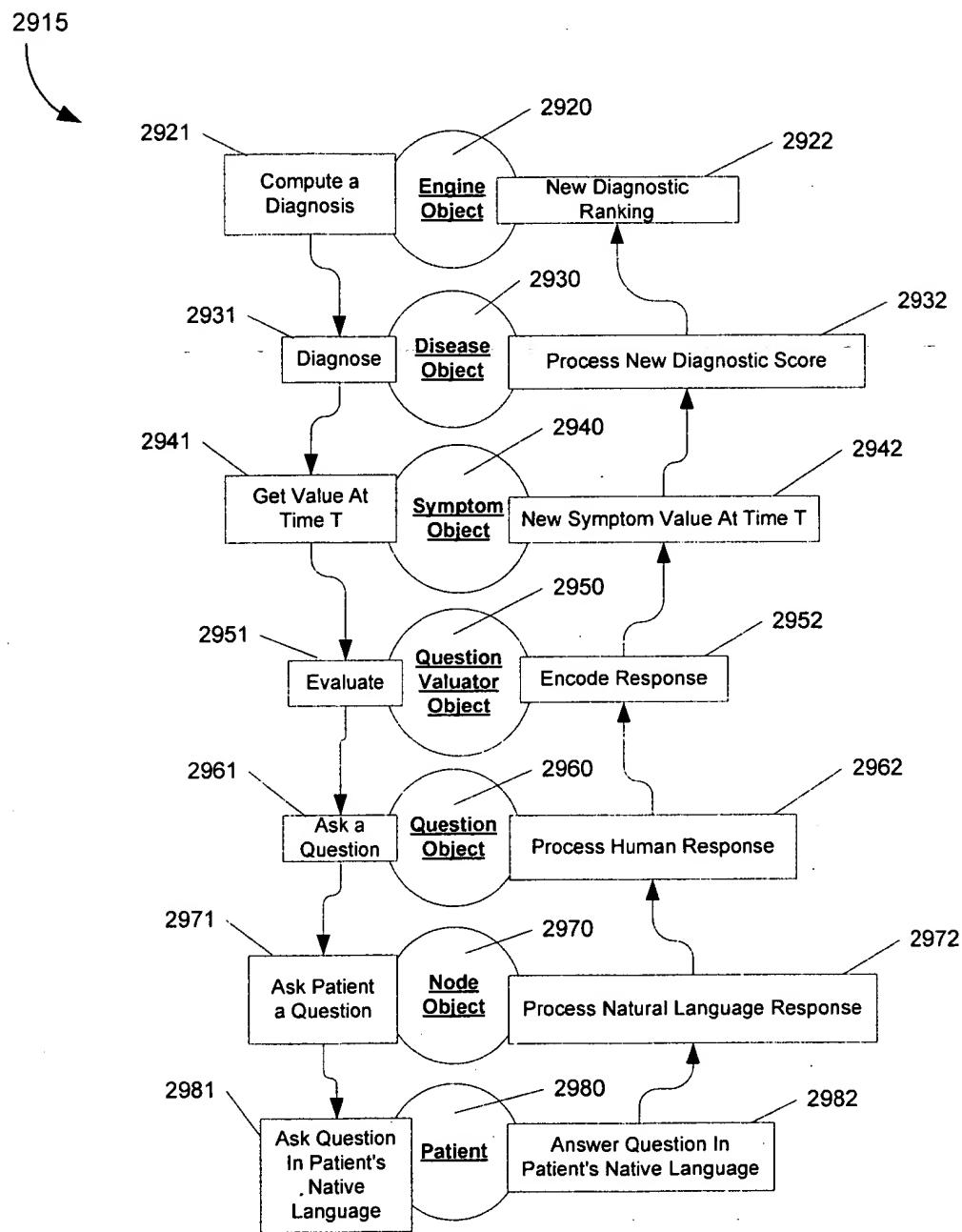


FIG. 29b

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Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Claims 2-5, 7-8, 10 and 12-17 are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

New Claims

Applicant has added new Claims 18-47. New dependent Claims 18 and 43 are supported at least by page 80 of the specification and Figure 30. New dependent Claims 19 and 44 are supported at least by page 83 of the specification and Figure 32b. New dependent Claims 20 and 32 are supported at least by pages 76-77 of the specification and Figure 29a. New dependent Claims 21-23, 31, 33 and 34 are supported at least by pages 77-80 of the specification and Figure 29b. New dependent Claims 24, 35 and 45 are supported at least by page 13 of the specification. New dependent Claims 25-26, 36-37 and 46-47 are supported at least by page 15 of the specification. New dependent Claims 27 and 38 are supported at least by page 76 of the specification. New dependent Claims 28 and 39 are supported at least by page 10 and 12 of the specification. New dependent Claims 29 and 40 are supported at least by page 11 of the specification. New dependent Claims 30 and 42 are supported at least by page 13 of the specification. New dependent Claim 41 is similar to Claim 8.

CONCLUSION

Because of the reasons presented above, the Iliff reference does not teach or suggest each and every element of Applicant's Claims 6-8, the combination of the Branson and Gray references does not teach or suggest Claims 1-5 and 9-10, the combination of the Iliff and Gray references

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does not teach or suggest Claims 11-13 and 15-17, and the combination of the Iliff, Gray and Branson references does not teach or suggest Claim 14. Since it is respectfully submitted that the rejections have been overcome, Applicant respectfully requests allowance of all claims.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections are specifically requested. Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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